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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL BONAVENTURA, WAYNE A. BUTTLERMORE,
DAVID J. CASH, and JOHN LEVIN

Appeal No. 2009-0435
Application No. 10/733,628
Technology Center 2800

Decided: January 22, 2009

Before KENNETH W. HAIRSTON, JOSEPH L. DIXON, and
ALLEN R. MACDONALD, Administrative Patent Judges.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-6, 9-15, and 17-20. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal relates generally to microscopes, and more particularly, to a contrasting means for a microscope stage that allows a user to orient a specimen thereon. (Spec. 1.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A microscope stage comprising:

an upper stage comprising a first color; said upper stage comprising a recess therein; and

a non-transparent contrasting stage insert comprising a second color different from said first color; said non-transparent contrasting stage insert configured for removable complementarily receipt within said recess.

C. REFERENCES

The Examiner relies on the following references as evidence:

Fischer	US 4,436,385	Mar. 13, 1984
Sattler	US 4,906,083	Mar. 6, 1990
Douglas-Hamilton	US 5,306,467	Apr. 26, 1994
Kapitza	US 5,781,338	Jul. 14, 1998

D. REJECTIONS

The Examiner makes the following rejections.

Claims 1-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton in view of Kapitza.

Claims 9-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton in view of Kapitza.

Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton in view of Kapitza as applied above, and further in view of Fischer.

Claims 17-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton in view of Sattler.

II. ISSUE

Has the Examiner set forth a sufficient showing of obviousness and have Appellants shown error therein. Specifically, what is a stage for a microscope and does Hamilton-Douglas teach or fairly suggest a stage for a microscope

III. PRINCIPLES OF LAW

35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John*

Deere Co., 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162(citing *KSR*, 127 S. Ct. at 1740-41).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

IV. ANALYSIS

Appellants maintain that the Examiner has not set forth rationale or explanation for the combination of Douglas-Hamilton and Kapitza. (App. Br. 8). While we agree with Appellants that the Examiner's statement of rationale for combining the teachings of Douglas-Hamilton and Kapitza

appears to be conclusory, we note that the Examiner has merely relied upon Kapitza to evidence the use of varied colors in a device. We note that generally the use of colors was well known to those skilled in the art to distinguish articles manufactured by different sources and to identify association of parts, but color generally would not differentiate one article's functionality from another article's functionality. Therefore, we find ample motivation to those of ordinary skill in the art to use color both functionally and aesthetically in machines or articles. Therefore, we find the Examiner has set forth a sufficient reasoned statement for the combination of teachings.

Appellants argued that Douglas-Hamilton does not teach or suggest a microscope stage. (App. Br. 9). Appellants contend that the slide loading apparatus of Douglas-Hamilton can not be the recited microscope stage in independent claim 1. (App. Br. 9). Appellants contend that Douglas-Hamilton does not illustrate a microscope in their drawings nor does Douglas-Hamilton describe a microscope in their Specification. (App. Br. 9). While Appellants cite column 5 of Douglas-Hamilton to evidence a differentiation between a stage and a slide loading device, it is our reasoned conclusion that Douglas-Hamilton is clearly used with a microscope and in microscopy. Therefore, the question is what is a stage for a microscope.

Here, we find that the instant claimed invention is drafted with such broad limitations to recite virtually no limitations of the structure of the microscope and stage beyond an upper stage and a contrasting stage with two colors and a recess. Furthermore, we find no limitations to put the microscope stage in any specific context with respect to the whole spectrum of microscopes. Therefore, giving the language of independent claim 1 its

broadest reasonable interpretation, we agree with the Examiner that the slide loading mechanism may be considered an upper stage wherein the stage is used with a microscope and it is an additional staging area for samples to be viewed with the use of a microscope. Therefore, we find Appellants' argument to be unpersuasive of error in the Examiner's initial showing of obviousness. Appellants argue that Douglas-Hamilton does not expressly teach the use of their device as a microscope stage, but instead disclose that the device is a slide loading apparatus for use in an automated cell counting system or for use with standard optical microscopes for measuring the number of cells in a fluid biological sample. (App. Br. 9). Given that no limitations are specifically recited detailing a microscope in the language of independent claim 1, we find that Appellants' argument has the opposite of its intended effect in that the argument is persuasive that the slide loading apparatus is clearly for use with a microscope and thereby may be considered a microscope stage.

Appellants contend that the Examiner is ignoring the preamble language "microscope stage" (App. Br. 9) and the broadest reasonable interpretation consistent with Appellants' Specification is that the slide loading apparatus of Douglas-Hamilton has no structural resemblance to Appellants' claimed microscope stage (App. Br. 10-11). We take issue with Appellants' contentions since Appellants seem to desire to read the structural limitations of the microscope into Appellants' mere recitation of a microscope stage.

Here, we do not find the Examiner's treatment of the instant claimed language to be unreasonable. If Appellants desired further context for their claimed invention, Appellants could have added limitations to limit the

context. Appellants chose not to provide express limitations to the structure of the microscope or other related structures. Appellants argue that the teachings of Douglas-Hamilton have no relevance to Appellants' claimed invention. Here, Appellants mere argument thereto does not differentiate the claimed invention from the teachings as set forth by the Examiner. Therefore, Appellants have not shown error in the Examiner's initial showing of obviousness.

Appellants argue that the combination of Douglas-Hamilton and Kapitza fails to teach, suggest or provide motivation for the non-transparent contrasting stage insert recited in Appellants' claims 1 and 9. First, to interpret Appellants' claim language, we look to Appellants' Specification, but we find no express usage of "non-transparent" in Appellants' Specification. Therefore, we give this term its broadest reasonable interpretation using the ordinary and customary meaning.

Appellants argue that nothing disclosed by Douglas-Hamilton teaches or suggests the U-shaped retainer clamp can provide a background color for contrast against a specimen that is being positioned on an upper stage. (App. Br. 11). Here, we find Appellants' argument goes beyond the express language of independent claim 1 and independent claim 1 does not set forth a background color for contrast against a specimen. We agree with the Examiner concerning the lack of support in the claim language of the arguments (Ans. 13) and find no limitation as to what is the background or where the specimen is located in independent claim 1. Therefore, Appellants' argument is not commensurate in scope with independent claim 1. Therefore, Appellants' argument is not persuasive of the error in the Examiner's initial showing of obviousness.

Appellants further contend that the term "contrasting" indicates the stage insert contrasts with the specimen placed thereon and that this interpretation is fully supported by the written description provided by the instant application. (App. Br. 11-12). We disagree with Appellants since Appellants have identified no express support for this interpretation in the instant claim language or Specification, and such an interpretation is mere unsupported argument.

Appellants further contend that Douglas-Hamilton does not teach a non-transparent contrasting stage insert as recited in independent claim 1 and further that the insert is complementary with a recess. (App. Br. 12). Appellants further contend that even if the contrasting colors of the stage insert and the upper stage were present in the holder of Douglas-Hamilton, the holder would be inoperable as contrasting backgrounds to aid in the positioning of a specimen because the slide in Douglas-Hamilton is not positioned over holder 10 and clamp 20, but is positioned inside the U-shaped void in clamp 20 over recess 14 and aperture 18. We do not find Appellants' argument commensurate in scope with the language of independent claim 1 since independent claim 1 is silent as to the argued features and placement of a specimen. (App. Br. 12). Therefore, Appellants' argument to unclaimed subject matter is not persuasive of the error in the Examiner's initial showing of obviousness. Therefore, we find that Appellants have not shown error in the Examiner's initial showing of obviousness, and we will sustain the rejection of independent claim 1 and independent claim 9 grouped therewith by Appellants.

We similarly sustain the rejections of dependent claims 2-5 and 10-15 grouped with their respective independent claims.

With respect to dependent claim 6, Appellants contend that the teachings of Fischer do not disclose a stage insert with the releasable fastening means comprising a springed detent (App. Br. 14) and that while Fischer teaches the use of spring detents, this structural feature lacks the releasable properties associated with Appellants' detent and therefore does not meet the limitations of dependent claim 6. Appellants further opine that the Examiner is relying upon hindsight reconstruction. (App. Br. 14-15)

We disagree with Appellants' contentions since we find no express text which correlates to Appellants' asserted releasable properties of the claimed "springed detent." Furthermore, we find no springed detent from our review the Specification and Appellants have not identified corresponding disclosure thereof in the Summary of Claimed Invention. Therefore, we agree with the Examiner that the springed detent of Fischer would have fairly suggested the claimed springed detent. Furthermore, we find Appellants' conclusory argument regarding hindsight reconstruction to be unpersuasive of error in the Examiner's initial showing of obviousness and in the Examiner's stated line of reasoning for the combination. Therefore, Appellants have not shown error in the Examiner's initial showing of obviousness of dependent claim 6, and we will sustain the rejection thereof.

With respect to independent claim 17, Appellants rely upon the same arguments advanced with respect to independent claim 1 and maintain that there is no credible motivation provided for combining the teachings of Sattler with respect to a second color different from the first color with the teachings of Douglas-Hamilton. (App. Br. 17). Again, we find Appellants' conclusory argument unpersuasive of error in the Examiner's initial showing

of obviousness of independent claim 17. Appellants further argue that Appellants' non-transparent contrasting stage insert is not designed or disclosed as possessing key properties of the Douglas-Hamilton device. (App. Br. 18). Again, we find Appellants' arguments to be unpersuasive to show error in the Examiner's initial showing of obviousness of the claimed invention.

Appellants further opine that even if Sattler teaches the features wherein the gemstones may have a color different from the microscope stage, claim 17 would still not be arrived at because the structural features of the slide loading device of Douglas-Hamilton simply do not meet the limitations of Appellants' claims. (App. Br. 18). Here, we find Appellants' argument (App. Br. 18-19) unpersuasive of error in the Examiner's initial showing of obviousness since Appellants have not identified any structural differences/limitations in independent claim 17 nor have Appellants identified an error in the Examiner's stated motivation for the combination.

Appellants further argue that Sattler does not repair the defects of Douglas-Hamilton and fails to teach the element the Examiner asserts is taught therein. (App. Br. 19). Appellants contend that Sattler does not disclose a non-transparent contrasting stage insert being of a different color from the second color of the specimen and that Sattler at column 4 teaches a "light-permeable and translucent, i.e., transparent" specimen holder. The Examiner maintains at pages 17-18 of the Answer that the disclosed embodiments of Sattler use various Plexiglas™ products but do not show pure transparency nor pure opacity, but do disclose a range of transparency. The Examiner identifies paragraphs [0022]-[0025] of Appellants' Specification which identifies a range of materials and transparencies. The

Examiner maintains that a broad, but reasonable interpretation of the term "non-transparent" would include translucent (where only part of the incident light passes through the material) materials as well as opaque (where no part of the incident light passes through the materials). We agree with the Examiner's broad, but reasonable interpretation of the term "non-transparent."

As discussed above, we find no express support for the claim terminology "non-transparent" in Appellants' Specification and Appellants have not identified any express support or definition thereof. Therefore, we find that the teachings of Sattler do teach and fairly suggest the use of both transparent and non-transparent materials. Additionally, we note that the Examiner did not rely upon the teachings of Sattler for teaching and fairly suggesting a non-transparent aspect of the claimed invention. (Ans. 17-18). Since Appellants have not shown error in the Examiner's initial showing of obviousness of independent claim 17, we will sustain the rejection of independent claim 17, and dependent claims 18-20 grouped therewith by Appellants.

VI. CONCLUSION

For the aforementioned reasons, we conclude that the Examiner has set forth a sufficient showing of obviousness, and Appellants have not shown error therein. Furthermore, we conclude that the slide holder of Hamilton-Douglas is fairly interpreted as a microscope stage as recited in the independent claims.

VII. ORDER

We sustain the obviousness rejections of claims 1-6, 9-15, and 17-20.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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